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10/026,450	12/27/2001	Hayato Minamishin	011734	1596

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EXAMINER

SCHLAK, DANIEL K

ART UNIT

PAPER NUMBER

3653

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/026,450

Applicant(s)

MINAMISHIN ET AL.

Examiner

Daniel K Schlak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The current title describes about 100,000 US patent documents and gives no hint of the novel features.

### ***Claim Objections***

Claim 4 is objected to because of the following informalities: in line 19 of the claim, the word "fourth" has been misspelled "forth". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

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To begin with, the claims are basically of the process/method type, but are in the guise of apparatus claims. Very few structural elements are mentioned, all of which appear in just about every automatic teller machine currently being made. The claims rely on an over abundance of functional recitations which not only confuse the actual potential of the structural elements to be described insofar as they work together, interconnect, etc.

Each independent claim begins as an apparatus claim, and then, before even offering a structural element or physical relationship between any parts, begins a narrative description of what happens to the papers inside the apparatus. As the method, or whatever it is, is so narrative and confusing, the Examiner has been only able to find the structural limitations in claims and apply art to the claims in light of only the structural elements which are positively and unambiguously recited. There is no way to determine from the claims what is actually happening in and among the claimed structure. The Examiner has been able to infer from the claims the following structural elements:

- a) four conveyance paths which are all linked together somehow;
- b) apparatus for delivering to the exterior, and a device for receipt of papers from the exterior.
- c) cassettes of two types which are removable (all cassettes in ATM's are removable);
- d) temporary storage;
- e) some type of determining mechanism for judging bills to be inadequate;

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However, the claims do not mention a controller or any means for establishing the functional recitations of the claims, thus it must be assumed that any machine comprising the elements given above is capable of performing the 'method' of the claims, given that the paths are all linked together in such a way that the functional recitations can be effected.

To begin with, the claims describe reject bills as "papers having difficulties with delivery after being fed from the first paper storing section". What does this mean? What difficulties? Is Applicant claiming difficulties? How does the claim apply to a similar device which has no problem feeding from the cassettes?

Claim 1 recites that the paper storing section is "for storing papers delivered to an exterior, conveyed on a predetermined first conveyance path, temporarily stored in a predetermined temporary storing section, and delivered from a predetermined paper delivery section..." How can papers be stored, delivered, conveyed, and temporarily stored at the same time?

Claim 3 recites "the led papers" in lines 4 and 5. What led papers? What is a led paper? As all the papers are more or less "led" throughout the device, aren't they all led papers?

Claim 4 in line 6 recites "and then delivered..." When? This is an apparatus claim, and no chronology should be the subject of any structural relationship.

Claim 4, in lines 16-17, recites "the received papers". All of the papers in the device have been "received".

Claim 4, line 20, recites "the papers fed from the exterior..." All of the papers, at some point, have been fed from an exterior.

Claim 5, in line 6, recites "the stored papers are led..." How can a paper be stored and led? What is a stored paper?

The foregoing represents evidence of a pattern which is perhaps the paramount failing of the claims. All of the papers in the device have been stored, fed, led, and temporarily stored.... Thus, how can a claim refer to a certain paper or group of papers as "stored", "fed", "led", "temporarily stored", etc.? How can such designation be given to papers when all of the papers in the device have been at some point or another subjected to every single one of these processes?

Further, how can any of these functional recitations be realized without means for controlling? Without a control means, the claims are non-functional in any interpretation. Certainly the paths don't just move the papers around of their own caprice.

Claims 9 and 12 discuss cassette mounting boxes of first and second types but then say that the second type is optional. Then, one must wonder, has it been claimed?

Claim 3, in the last line thereof, recites "according to operation..." What operation?

It is the Examiner's belief that the claims must be completely revised to comply with U.S. practice, both for clarity as a published legal document, and for application of art thereto. If there is some physical structure that is novel, then it should be claimed in an apparatus claim and such claim should avoid relying so heavily on the movement of

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the papers through the device. If the novelty to be claimed is more pertinent to the movement of papers through the device, then a method claim would be more appropriate, or a claim for the control system for effecting the movement.

The Examiner has only included a few examples of the instances of indefinite, vague subject matter, as it is not the duty of the Office to instruct on how to write claims. The true lack of foundation in relying on functional recitations for apparatus claims will be more and more evident during the application of art in the following rejections under 35 U.S.C. 102.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

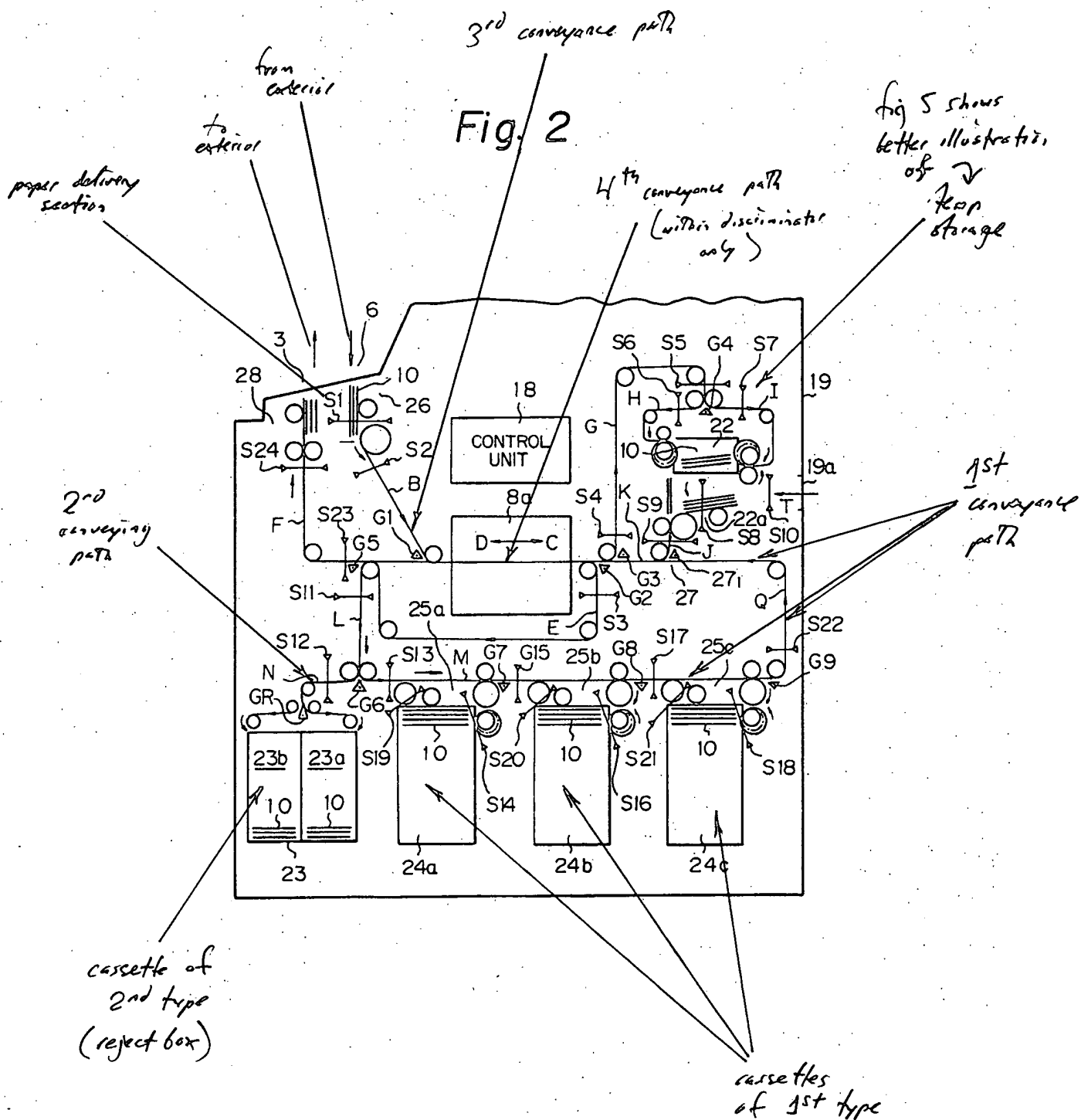
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,625,870 to Nao.

On the following page, the Examiner has included a copy of figure 2 of Nao et al. with the conveyance paths, cassettes, and other pertinent elements clearly labeled. As all of the conveyance paths effectually feed directly or indirectly to all other conveyance paths and, eventually, to the exterior and the reject box, the functional recitations are inherent.





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Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,254,083 to Abe et al (different inventive entity).

On the following page, the Examiner has included a copy of figure 2 of Abe et al. with the conveyance paths, cassettes, and other pertinent elements clearly labeled. As all of the conveyance paths effectually feed directly or indirectly to all other conveyance paths and, eventually, to the exterior and the reject box, the functional recitations are inherent.

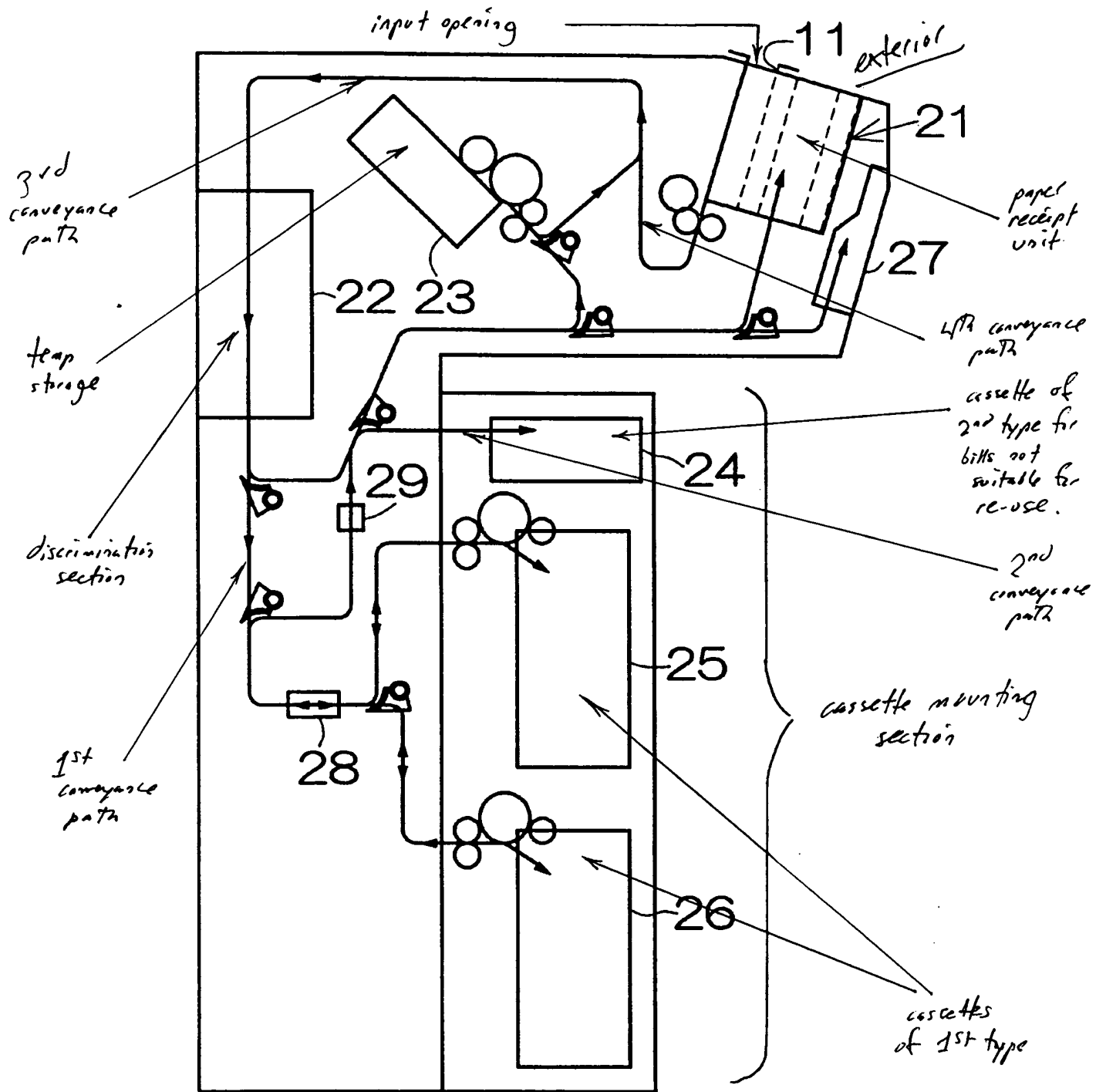


FIG. 2

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Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 8-221637.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 5-159136.

These documents clearly show the four conveyance paths, as claimed in the claims and all together linked, two different types of cassettes in a cassette storing area, temporary storage, a reject box as one of the cassettes, a discrimination device, and the paths seem to be arranged in such a way that papers from the exterior and papers from the cassettes of the first type could be circulated to the second path and into the cassette of the second type, with the option to temporarily store papers after discrimination, and with the capability of passing papers from the temporary storage to the exterior.

The Examiner is basing this judgment solely on the figures, and cannot doubt the ability of the devices shown therein to perform according to the functional recitations of the claims unless a full translation of each is submitted.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The claims are simply too broad, too confusing, and overly narrative. Once Applicant has provided apparatus claims which adhere to US practice concerning apparatus claims, or has changed these quasi-method claims into full-to-form method

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claims, the Examiner will re-examine the claims in light of a new search and, probably, new art. The Examiner at present cannot tell from the application what is considered the novelty of the instant application over the references, as the references have not been discussed, their deficiencies have not been described, and it seems that there are very few features discussed in the instant application which do not appear in much of the prior art known to the Examiner. However, this could be solely due to the confusion caused by the narrative nature of the claims.

For example, even Japanese published application number 2000-200379 reads on several of the claims, and is available as prior art under 35 U.S.C. 102(b).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel K Schlak whose telephone number is 703-305-0885. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306 - 4173. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

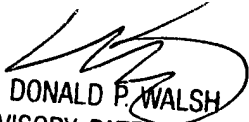
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308 - 1113.

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